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| APPLICATION NO. | PLICATION NO. FILING DATE | | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|------------------------|---------------------------|---------------|--------------------------|---------------------|------------------|
| 09/320,172 | 09/320,172 05/26/1999 | | ASCHER SHMULEWITZ | CIR-002-CIP2 | 4246 |
| 33197 | 7590 06/03/2005 EXAMINER | | | | |
| STOUT, UI 4 VENTURI | , | YAN & MULLINS | MENDEZ, N | MENDEZ, MANUEL A | |
| IRVINE, CA | , | | ART UNIT | PAPER NUMBER | |
| | | | | 3763 | |
| | | | DATE MAIL ED. 06/02/2006 | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | • | • | (/) | | |
|---|--|--|--|-------------------|--|
| | | Application No. | Applicant(s) | | |
| | | 09/320,172 | SHMULEWITZ ET | SHMULEWITZ ET AL. | |
| | Office Action Summary | Examiner | Art Unit | | |
| | | Manuel Mendez | 3763 | | |
| Period fo | The MAILING DATE of this communication ap or Reply | pears on the cover sheet | with the correspondence add | iress | |
| THE - Exte after - If the - If NC - Failu Any | ORTENED STATUTORY PERIOD FOR REPL MAILING DATE OF THIS COMMUNICATION. nsions of time may be available under the provisions of 37 CFR 1. SIX (6) MONTHS from the mailing date of this communication. period for reply specified above is less than thirty (30) days, a reper population of the provision of the provision of the period for reply is specified above, the maximum statutory period into the provision of the pr | 136(a). In no event, however, may ly within the statutory minimum of will apply and will expire SIX (6) Me, cause the application to become | a reply be timely filed thirty (30) days will be considered timely ONTHS from the mailing date of this co ABANDONED (35 U.S.C. § 133). | mmunication. | |
| Status | | | | | |
| 1)[🖂 | Responsive to communication(s) filed on 04 N | May 2005. | | | |
| •— | • | s action is non-final. | | | |
| 3) | Since this application is in condition for allowa | nce except for formal m | atters, prosecution as to the | merits is | |
| , | closed in accordance with the practice under | Ex parte Quayle, 1935 C | D. 11, 453 O.G. 213. | | |
| Disposit | ion of Claims | | | | |
| 4)⊠ | Claim(s) 1-3,16,20-22,24,25,27,30,31,34 and | 35 is/are pending in the | application. | | |
| ٠,٣ | 4a) Of the above claim(s) is/are withdra | | | | |
| 5) | Claim(s) is/are allowed. | | ٠. | | |
| 6)⊠ | Claim(s) 1-3, 16, 20-22, 24-25, 27, 30-31, and | d 34-35 is/are rejected. | | | |
| 7) | Claim(s) is/are objected to. | | | | |
| 8)[| Claim(s) are subject to restriction and/o | or election requirement. | | | |
| Applicat | ion Papers | | | | |
| 9)□ | The specification is objected to by the Examine | er. | | | |
| 7— | The drawing(s) filed on is/are: a) acc | | to by the Examiner. | | |
| ,_ | Applicant may not request that any objection to the | | | | |
| | Replacement drawing sheet(s) including the correct | | | R 1.121(d). | |
| 11) | The oath or declaration is objected to by the E | xaminer. Note the attact | ned Office Action or form PT | O-152. | |
| Priority (| under 35 U.S.C. § 119 | • | | | |
| • | Acknowledgment is made of a claim for foreign ☐ All b) ☐ Some * c) ☐ None of: | n priority under 35 U.S.C | c. § 119(a)-(d) or (f). | | |
| • | 1. Certified copies of the priority documen | ts have been received. | | | |
| | 2. Certified copies of the priority documen | ts have been received ir | Application No | | |
| | 3. Copies of the certified copies of the price | ority documents have be | en received in this National | Stage | |
| | application from the International Burea | nu (PCT Rule 17.2(a)). | | | |
| * (| See the attached detailed Office action for a list | t of the certified copies n | ot received. | | |
| | · | | | | |
| | | | | | |
| Attachmen | nt(s) | • | | | |

1) Notice of References Cited (PTO-892)

Paper No(s)/Mail Date _

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

6) Other: ___

5) Notice of Informal Patent Application (PTO-152)

Application/Control Number: 09/320,172

Art Unit: 3763

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 16, 20-22, 24-25, 27, 30-31, and 34-35 rejected under 35 U.S.C. 103(a) as being unpatentable over Jarvik, et al. The cited patent discloses an inlet conduit configured to be inserted into a source of oxygenated blood, the inlet conduit having an inlet end, an outlet end and a lumen extending between the inlet end and the outlet end; an outlet conduit having an inlet end, an outlet end and a lumen extending between the inlet end and the outlet end, the outlet end configured to be inserted into the patient's coronary venous vasculature; a coupler for coupling the outlet end of the inlet conduit to the inlet end of the outlet conduit.

In relation to the location of the coupler, a recitation with respect to the manner in which an apparatus is intended to be employed does not impose any structural limitation upon the claimed apparatus, which differentiates it from a prior art reference disclosing the structural limitations of the claim. <u>In re Pearson</u>, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974). Accordingly, the location of the coupler is considered an intended use, and therefore, such language does not provide any patentable weight.

Based on the above observations and comments, for a person of ordinary skill in the art, modifying the location of the coupler disclosed by **Jarvik**, **et al.**, from inside the Art Unit: 3763

body to outside the body or vice-versa would have been considered an obvious design choice.

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Response to Amendment

The examiner notes for the record that the phrase "sized and constructed so as to be implanted within the chest cavity of the subject" provides no further structural limitation to the claim. Therefore, the above phrase cannot overcome the above rejection.

Furthermore, for a person of ordinary skill in the art, specific sizes and dimensions critical for the use of implantable medical devices in the body are conventional in the art since, absent of any criticality in the specification, it is the human body that determines the size of the system and not the inventor. Accordingly, said sizes and dimensions should be considered obvious.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manuel Mendez whose telephone number is 703-308-2221. The examiner can normally be reached on 0730-1800 hrs. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Brian Casler can be reached on 703-308-3552. The fax phone number for the organization where this application or proceeding is assigned is 703-305-3590.

Manuel Mendez Primary Examinèr

Art Unit 3763